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Filing date: **08/03/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92051143
Party	Defendant Consortium Deutscher Baumschulen GmbH
Correspondence Address	Russell D. Orkin Webb Ziesenheim Logsdon Orkin & Hanson, P.C. 700 Koppers Building, 436 Seventh Ave. Pittsburgh, PA 15219-1818 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Russell D. Orkin
Filer's e-mail	webblaw@webblaw.com
Signature	/RDO/
Date	08/03/2009
Attachments	answer to petition to cancel.pdf (4 pages)(236350 bytes) exhibit A to answer.pdf (10 pages)(623557 bytes)

Registration Subject to the filing

Registration No	2988914	Registration date	08/30/2005
International Registration No.	NONE	International Registration Date	NONE
Registrant	Inter-Plant Patent Marketing, Inc. R.R.2 Niagara-on-the-Lake Ontario, L0S 1J0 CANADA		

Goods/Services Subject to the filing

Class 031. All goods and services in the class are requested, namely: Cherry rootstock

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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INTER-PLANT PATENT)	Cancellation No. 92051143
MARKETING, INC.,)	
A Canadian corporation)	Registration No. 2,927,770
)	
Petitioner,)	Mark: GISELA and Design
)	
v.)	
)	
CONSORTIUM DEUTSCHER)	
BAUMSCHULEN GmbH,)	
A German corporation)	
)	
Registrant.)	

ANSWER TO PETITION TO CANCEL

Consortium Deutscher Baumschulen, GmbH ("Registrant"), by and through its attorneys, hereby responds to the individually numbered paragraphs of the Petition to Cancel filed by Inter-Plant Patent Marketing, Inc. ("Petitioner") before the Trademark Trial and Appeal Board as follows:

1. Admit.
2. Registrant admits that Petitioner appears to be the record owner of U.S. Trademark Registration No. 2,988,914, registered on August 30, 2005. Registrant has insufficient information to either admit or deny the remaining allegations set forth in paragraph 2 of the Petition to Cancel, and for this reason, denies such allegations. Further, paragraph 2 contains conclusions of law which Registrant need not admit or deny, but nevertheless, Registrant denies the same.
3. Denied.
4. Denied.

5. Denied.
6. Denied.
7. Denied.

**COUNTERCLAIM FOR CANCELLATION OF PETITIONER'S
U.S. TRADEMARK REGISTRATION NO. 2,988,914**

Consortium Deutscher Baumschulen, GmbH ("Registrant"), in support of its Counterclaim against Inter-Plant Patent Marketing, Inc. ("Petitioner") hereby avers:

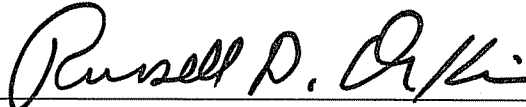
1. GISELA is a coined term and Registrant licensed the Prunus GISELA varieties to IPPM (Petitioner) and Mori Nurseries Ltd. for the American continent. A copy of a certified translation of the license agreement is attached hereto as Exhibit A.
2. To the extent that the Trademark Trial and Appeal Board deems GISELA to be a valid trademark, Registrant is the sole and rightful owner of the GISELA trademark.
3. Petitioner obtained U.S. Trademark Registration No. 2,988,914 for GISELA through fraud on the Patent and Trademark Office due to the fact that Petitioner was not the true owner of the mark and due to the fact that Petitioner did not disclose Registrant's rights to the name GISELA.
4. Registrant is, or will be, damaged as a result of the registration of, and the likelihood of confusion with, Petitioner's mark for GISELA.
5. Pursuant to 15 U.S.C. §1064, Petitioner's mark for GISELA must be cancelled.

The fee required by 37 C.F.R. §2.6(a)16 has been paid as part of this electronic filing. The United States Patent and Trademark Office is authorized to charge or refund any fee deficiency or excess to Deposit Account No. 23-0650 in the name of The Webb Law Firm.

WHEREFORE, Registrant requests that Petitioner's Petition to Cancel be dismissed with prejudice.

Respectfully submitted,

Dated: August 3, 2009

By 

Russell D. Orkin, Registration No. 25,363
J. Matthew Pritchard, Registration No. 46,228
Patricia A. Olosky, Registration No. 53,411


THE WEBB LAW FIRM
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E-mail: webblaw@webblaw.com

Attorneys for Registrant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **ANSWER TO PETITION TO CANCEL** was served via First Class Mail, postage prepaid, on this 3rd day of August, 2009 upon the following:

Robert L. Kelly, Esq.
DICKINSON WRIGHT PLLC
38525 Woodward Avenue
Suite 2000
Bloomfield Hills, MI 48304



Attorney for Registrant

Exhibit

A

Consortium Deutscher Baumschulen
Dubenhorst 27, 2087 Ellerbek / Phone: 04101 – 31085

Agreement

1) The Parties

- 1.1 Consortium deutscher Baumschulen (CdB), 2087 Ellerbek
- 1.2 Mori Nurseries CTD, Niagara on the Lake Ontario LOS 1 J0 together with
INTER PLANT PATENT MARKETING INC., hereinafter referred to as Mori.

2) The varieties

Species crossing of Prunus. "Prunus GISELA" for the dwarfing of cherries grown by the University of Giessen under Prof. Dr. Gruppe and Prof. Dr. Schmidt (see Appendix).

3) The rights

Meanwhile plant varieties protection for 3 varieties of Prunus GISELA 1, 5 and 10 has been applied for with the Bundessortenamt [German Federal Office of Plant Varieties] in Hanover.

4) Object of the agreement

- 4.1 CdB would like to make arrangements regarding the sale of the aforementioned varieties on the American continent within the scope of an exclusive agreement concluded with Mori.
- 4.2 Only the General Licensee is authorized to grant sublicenses in countries of the American continent. Such sublicense agreements shall follow the same provisions as this main agreement. This, however, shall not apply to the fees.

- 4.3 After prior consultation with Prof. Gruppe, the Consortium deutscher Baumschulen (CdB) shall commission Mori Nurseries to conclude a sublicense agreement with WALLACE E. Heuser, Michigan 49064, for the USA. As regards the content, that agreement shall be largely identical to the agreement concluded between CdB and Mori Nurseries.

5) Terms and conditions to be met by General Licensee

- 5.1 General Licensee undertakes to pay an annual amount of 5,000.00 Deutschmarks (DM) for development activities to the University of Giessen.
- 5.2 General Licensee undertakes to pay an annual amount of 5,000.00 Deutschmarks (DM) for further development of the numerous clones from Giessen still to be examined and selected to CdB.
- 5.3 Every sublicensee shall pay an annual flat fee of 2,500.00 Deutschmarks (DM) to CdB via General Licensee.
- 5.4 General Licensee undertakes to pay a license fee in the amount of 15% of the sales price obtained for all GI-Sel-A rootstocks sold on the American continent. The annual payments of DM 5,000.00 according to Paragraph 5.1 may be set off against the license fee incurred.
- 5.5 An annual settlement shall be submitted by July 31. Payment of the licensee fee is due together with the settlement. General licensee undertakes to prepare all documents regarding sales and sublicenses and submit them to CdB. CdB shall be entitled to inspect the propagation and cultivation areas at any time.

- 5.6 General licensee undertakes to apply for plant varieties protection in Canada as soon as possible and in the USA with immediate effect at its own expense. Application for plant varieties protection in additional American countries (Central and South America) shall either be filed by General Licensee Mori, or by a company in the particular country at Mori's discretion. CdB shall continue to be the proprietor of the varieties. General Licensee is liable towards CdB with all its actions that plant varieties protection shall remain in force on the American continent wherever such protection has been applied for.
- 5.7 General Licensee is committed towards CdB to prevent all improper propagation on the American continent with all legal means available. Depending on the scope of the improper propagation, General Licensee may take legal action at its discretion.
- 5.8 Mori shall continue to track and support the experiments for the NORTH CENTRAL ROOTSTOCK RESEARCH PROJECT (NC 140) initiated by Hilltop as well as experiments at universities in the USA and other countries of the American continent. Reports from these experiments shall be submitted to CdB on an annual basis.

6) Conditions of sale

- 6.1 General Licensee undertakes to provide at least every 100th plant sold with a label referring to the registered varieties protection in the particular country.
- 6.2 The license is only granted for the territory of the American continent. Exports from the American continent are not admissible. Exceptions shall only be granted for deliveries to members of the Consortium or subsequent further exclusive representatives in other countries, however, only after prior consultation with CdB.

7) Obligations on the part of CdB

- 7.1 CdB shall provide the mother plant material required either itself or via suppliers from the Consortium. Deliveries shall be effected at cost price.
- 7.2 If required, CdB shall provide photo material or other material demonstrating the particular characteristics of those grafting rootstocks.
- 7.3 CdB undertakes not to grant any other licenses on the American continent for the term of this agreement.
- 7.4 CdB has received further species crossing combinations from the University of Giessen. Said combinations are propagated and pomologically examined. CdB shall prepare annual reports regarding those activities and results. As soon as new combinations are recognized to be valuable, plant varieties protection shall be applied for in Germany and the combinations shall be offered to General Licensee.

8) Term

- 8.1 This agreement shall be in force for a period of 10 years and thereafter it shall be automatically renewed by periods of 5 years.
- 8.2 Notice of termination must be given 1 year prior to the expiry of the agreement.
- 8.3 Termination without notice shall only be possible in the event that General Licensee becomes insolvent or if contractual agreements are not kept. However, a correctional period of 3 months shall be observed.

9) Rescission and change provisions

9.1 If this agreement is rescinded, the license fees still incurred shall be properly paid to CdB. Any plant material still available shall be returned to CdB.

9.2 If the legal form changes or if the owner of the General Licensee changes, all rights and obligations may be transferred to the new proprietor after prior consultation with CdB.

10) Venue

10.1 It is agreed that this agreement is governed by the laws of the Federal Republic of Germany. Venue is the regional court at the registered office of CdB.

11) Severability clause

11.1 If any provision of this agreement violates current or future law on the American continent, all other provisions of the agreement shall remain in full force. The agreement shall not become invalid, voidable or unlawful as a result thereof.

Signed for CdB, Ellerbek

/Illegible signature/

Ellerbek, this */handwritten/* 22nd day of May 1990

/Illegible signature/

Signed for Mori Nurseries CTD, Niagara on the Lake Ontario

Niagara on the Lake Ontario, this */handwritten/* 22nd day of May 1990 */Illegible signature/*

Supplemental Agreement between CdB and Mori Nurseries

All agreements regarding Prunus Giessen concluded by Hilltop in sublicense in Asia, Australia, Africa and Europe shall be submitted to CdB.

The same applies to any agreements concluded with universities and institutes located on those continents.

In 1989 Tart Erikson, Oregon, received Prunus Giessen material from W. Heuser, former Hilltop manager, for propagation experiments. It is to be examined to which extent propagation via live stakes is possible. Mori is hereby informed about those experiments and commissioned to track those activities.

The Parties to this agreement agree that the agreement concluded between the University and Hilltop Intern. and the agreement concluded between CdB and Hilltop Intern. have become ineffective as a result of Hilltop's liquidation.

/Added handwritten:/

International Plant Management

W.E. Heuser, May 22, 1990

/Signed Wallace E Heuser/

Mori Nurseries, May 22, 1990

/Illegible signature/

CdB

May 22, 1990

/Illegible signature/

APPENDIX

GROUP SERIES OF CHERRY ROOTSTOCKS PRELIMINARILY SELECTED DURING FIELD CHECKING

♀		♂				
Cer	x	Can	148/1	148/2	148/8	148/9
Cer	x	Fru	154/4	154/5	154/7	
Fru	x	Avi	172/3	172/7	172/9	
Fru	x	Cer	173/5	173/9		
Can	x	Cer	195/1	195/2		
Can	x	Avi	196/4	196/13		
Cer	x	Avi	169/15	169/3		

/Added handwritten:/

Appendix to CdB-Mori Agreement

May 22, 1990

/Illegible signatures/

capacity of a translator for the English language, duly registered and commissioned by and to the President of the Landgericht München II [Munich II Regional Court], I do hereby certify the foregoing is, to the best of my knowledge and belief, a true and correct translation of a document prepared in the German language, whereof a copy has been submitted to me".

IN WITNESS WHEREOF I have hereunder set my hand and seal at Poing, Germany, this 21st day of February 2007.

Ingrid Heckl

Ingrid Heckl



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ver.

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